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09/972,424	10/04/2001	Chris E. Matichuk	22407-05676	8244

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EXAMINER

CHOUDHURY, AZIZUL Q

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/972,424

Applicant(s)

MATICHUK ET AL.

Examiner

Azizul Choudhury

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/15, 6/10, 2/15</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Scott et al (US Pat No: US006338094B1), hereafter referred to as Scott.

1. With regards to claim 1, Scott teaches a method of programming a media-based device over a network, the method comprising: locating an advertisement for a broadcast program while navigating a first web site; selecting the advertisement; and in response, automatically programming the media-based device to record the broadcast program (Scott teaches a design for playing a video in response to a webpage link. Scott's design allows users to click on a link (or banner) to download (equivalent to record) and view a TV file (program) on the computer or television (column 4, lines 30-46, Scott)).

2. With regards to claim 2, Scott teaches the method wherein the advertisement comprises a hyperlink to a second web site accessing the media-based device, the hyperlink being embedded in the first web site (Scott teaches a design allowing users to click on links or banners (column 3, lines 60-67, Scott). When a link or banner is linked, it is inherent that the user will be redirected to another website. Whether that website has a webpage on it or data depends on the site itself).
3. With regards to claim 3, Scott teaches the method, wherein selecting the advertisement and automatically programming the media-based device are invoked by one click on the hyperlink (In Scott's design, when a user clicks on a link or banner, the device automatically downloads and plays the video (column 4, lines 30-46, Scott). This is equivalent to the claimed one click programming).
4. With regards to claim 4, Scott teaches the method, further comprising: the second website monitoring a count of a number of times the hyperlink is selected; and the second website periodically collecting revenue from the first website based on the count (Scott's design has users click on links or banners and download content (column 4, lines 30-46, Scott). It is inherent that cookies are implemented in such a design. Furthermore, Scott goes on to state that user preferences are anticipated, meaning that user data is obtained and managed. Hence cookies must exist. So the claimed traits exist within Scott's design).

5. With regards to claim 5, Scott teaches the method, wherein the revenue comprises a percentage of advertising revenue associated with the advertisement (Scott's design has users click on links or banners and download content (column 4, lines 30-46, Scott). It is inherent that cookies are implemented in such a design. Furthermore, Scott goes on to state that user preferences are anticipated, meaning that user data is obtained and managed. Hence cookies must exist. So the claimed traits exist within Scott's design).
6. With regards to claim 6, Scott teaches the method, wherein the media-based device comprises a video replay system (Scott's design has the video content downloaded (column 4, lines 30-46, Scott), it is thus possible for the video to be replayed).
7. With regards to claim 7, Scott teaches the method, wherein selecting the advertisement comprises: determining a user selecting the advertisement; and authenticating the user with the media-based device (Scott's design has users click on links or banners and download content (column 4, lines 30-46, Scott). It is inherent that cookies are implemented in such a design. Furthermore, Scott goes on to state that user preferences are anticipated, meaning that user data is

obtained and managed. Hence user data is obtained through a login or setup method. So the claimed traits exist within Scott's design).

8. With regards to claim 8, Scott teaches the method, wherein determining a user selecting the advertisement comprises: extracting a cookie associated with the user; and forwarding the cookie to the media-based device (Scott's design has users click on links or banners and download content (column 4, lines 30-46, Scott). It is inherent that cookies are implemented in such a design.

Furthermore, Scott goes on to state that user preferences are anticipated, meaning that user data is obtained and managed. Hence cookies must exist. So the claimed traits exist within Scott's design).

9. With regards to claim 9, Scott teaches the method, wherein the cookie is extracted from a client enabled to communicate with the first website (Scott's design has users click on links or banners and download content (column 4, lines 30-46, Scott). It is inherent that cookies are implemented in such a design.

Furthermore, Scott goes on to state that user preferences are anticipated, meaning that user data is obtained and managed. Hence cookies must exist. So the claimed traits exist within Scott's design).

10. With regards to claim 10, Scott teaches the method, wherein the cookie is extracted from a computer hosting the first website (Scott's design has users

click on links or banners and download content (column 4, lines 30-46, Scott). It is inherent that cookies are implemented in such a design. Furthermore, Scott goes on to state that user preferences are anticipated, meaning that user data is obtained and managed. Hence cookies must exist. So the claimed traits exist within Scott's design).

11. With regards to claim 11, Scott teaches the method, wherein determining a user selecting the advertisement comprises: linking the first web site to a second web site; navigating to the second web site; and in response, the second web site prompting a user for identification data (Scott teaches a design allowing users to click on links or banners (column 3, lines 60-67, Scott). When a link or banner is linked, it is inherent that the user will be redirected to another website. Whether that website has a webpage on it or data depends on the site itself. In addition, Scott goes on to state that user preferences are anticipated, meaning that user data is obtained and managed. Hence means for obtaining identification data are present).

12. With regards to claim 12, Scott teaches the method, wherein determining a user selecting the advertisement comprises: determining the URL for the first web site; and determining partner identification information associated with the first web site (Scott teaches a design allowing users to click on links or banners (column 3, lines 60-67, Scott). When a link or banner is linked, it is inherent that

the user will be redirected to another website. Whether that website has a webpage on it or data depends on the site itself. In addition, Scott goes on to state that user preferences are anticipated, meaning that user data is obtained and managed. Obtained data is transferable).

13. With regards to claim 13, Scott teaches the method, wherein automatically programming the media-based device to record the broadcast program comprises: determining a user associated with the media-based device; a navigating from the first web site to a second web site; logging the user into the second web site; detecting whether the user selected the advertisement previously; and in response to the user previously not selecting the advertisement, the second web site communicating with the media-based device to record the broadcast program (Scott teaches a design allowing users to click on links or banners (column 3, lines 60-67, Scott). When a link or banner is linked, it is inherent that the user will be redirected to another website. Whether that website has a webpage on it or data depends on the site itself. In addition, Scott goes on to state that user preferences are anticipated, meaning that user data is obtained and managed. Hence means for obtaining identification data are present).

14. With regards to claim 14, Scott teaches the method, wherein the advertisement comprises a clickable online advertisement for a broadcast program to be aired

(Scott's design allows for a link or banner (equivalent to the claimed advertisement) to be clicked for a video to be broadcast (column 4, lines 30-46, Scott)).

15. With regards to claim 15, Scott teaches the method, where broadcast program comprises a television program (Scott's design allows for a link or banner (equivalent to the claimed advertisement) to be clicked for a video to be broadcast (column 4, lines 30-46, Scott). Television is simply a form of video).

16. With regards to claim 16, Scott teaches the method, where broadcast program comprises a cable program (Scott's design allows for a link or banner (equivalent to the claimed advertisement) to be clicked for a video to be broadcast (column 4, lines 30-46, Scott). Cable programs are simply forms of video).

17. With regards to claim 17, Scott teaches the method, where broadcast program comprises a pay-per-view program (Scott's design allows for a link or banner (equivalent to the claimed advertisement) to be clicked for a video to be broadcast (column 4, lines 30-46, Scott). Pay-per-view programs are simply forms of video).

18. With regards to claim 18, Scott teaches the method, where broadcast program comprises a satellite-based program (Scott's design allows for a link or banner

(equivalent to the claimed advertisement) to be clicked for a video to be broadcast (column 4, lines 30-46, Scott). Satellite-based programs are simply forms of video).

19. With regards to claim 19, Scott teaches a method of programming a media-based device to record content through a web based application, comprising: receiving a selection of an advertisement of a broadcast program to be aired; extracting identification information associated with a user making the selection and with broadcast program; accessing a source web service in response to the user selection received; logging into the source web service using the identification information; and the source web service programming the media-based device to record the broadcast program selected (Scott teaches a design for playing a video in response to a webpage link. Scott's design allows users to click on a link (or banner) to download (equivalent to record) and view a TV file (program) on the computer or television (column 4, lines 30-46, Scott)).

20. With regards to claims 20, 25 and 30, Scott teaches a method, wherein the media-based device records the broadcast program with one click from the user of the advertisement (Scott's design downloads (equivalent to record) the video (column 4, lines 30-46, Scott)).

21. With regards to claims 21, 26 and 39, Scott teaches a method, wherein the advertisement comprises a clickable online advertisement for a broadcast program (Scott's design allows for clickable links and banners (column 4, lines 30-46, Scott)).
22. With regards to claims 22 and 27, Scott teaches a method, further comprising: collecting revenue based on the advertisement selected (Scott's design allows for clickable links and banners (column 4, lines 30-46, Scott)). The claimed trait of collecting revenue is inherent in designs that access the Internet and make use of banners such as Scott's).
23. With regards to claims 23, 28, 32, 34, 36 and 38, Scott teaches a method, wherein the media-based device comprises a digital video recorder (Scott's design downloads the video data and allows users to play and view that video content (column 4, lines 30-46, Scott)). Figure 2 goes on to display how the design allows for storage and transceivers by which to retrieve and save video. Hence the set top box usable in conjunction with a television is equivalent to the claimed digital video recorder (DVR)).
24. With regards to claim 24, Scott teaches a computer-implemented method for controlling a media-based device through a virtual browser, the method comprising; the steps of the virtual browser: receiving a selection of an

advertisement of a broadcast program to be aired; extracting identification information associated with a user making the selection and with broadcast program; accessing an online web service using the identification information; and invoking the media-based device to record the broadcast program selected (Scott teaches a design for playing a video in response to a webpage link. Scott's design allows users to click on a link (or banner) to download (equivalent to record) and view a TV file (program) on the computer or television (column 4, lines 30-46, Scott)).

25. With regards to claim 29, Scott teaches method for programming a media-based device that is network enabled, comprising: receiving a user command that causes a first server to access a second server, the first server transmitting identifying information of the user to the second server; the second server authenticating the user based on the identifying information; the second server accessing the media-based device to program the media-based device with the identifying information (Scott teaches a design for playing a video in response to a webpage link. Scott's design allows users to click on a link (or banner) to download (equivalent to record) and view a TV file (program) on the computer or television (column 4, lines 30-46, Scott)).

26. With regards to claim 31, Scott teaches the method, wherein the advertisement identifies a broadcast program to be aired, and the identifying information

comprises data related to the broadcast program (Scott's design allows for the banner or link to advertise the ad and when clicked, allows the user to view the video commercial (column 3, lines 60-67, Scott)).

27. With regards to claim 33, Scott teaches a system, comprising: a client side system selecting an online advertisement for a broadcast program while navigating a first web site; and a server side system automatically programming a media-based device to record the broadcast program, the media-based device communicatively coupled to the server side system over a network in response to the advertisement being selected (Scott teaches a design for playing a video in response to a webpage link. Scott's design allows users to click on a link (or banner) to download (equivalent to record) and view a TV file (program) on the computer or television (column 4, lines 30-46, Scott)).

28. With regards to claim 35, Scott teaches a browser program product: for programming a media-based device over a network, the browser program product stored on a computer readable medium and adapted to perform the operations of: locating an advertisement for a broadcast program while navigating a first web site; selecting the advertisement; and in response, automatically programming the media-based device to record the broadcast program (Scott teaches a design for playing a video in response to a webpage link. Scott's design allows users to click on a link (or banner) to download

(equivalent to record) and view a TV file (program) on the computer or television (column 4, lines 30-46, Scott)).

29. With regards to claim 37, Scott teaches a computer server program product for programming a media-based device over a network, the computer server program product stored on a computer readable medium, and adapted to perform the operations of a virtual browser, comprising: receiving a selection of an advertisement of a broadcast program to be aired; extracting identification information associated with a user making the selection and with broadcast program; accessing an online web service using the identification information; and invoking the media-based device to record the broadcast program selected (Scott teaches a design for playing a video in response to a webpage link. Scott's design allows users to click on a link (or banner) to download (equivalent to record) and view a TV file (program) on the computer or television (column 4, lines 30-46, Scott)).

Remarks

The claimed invention, as currently written, lacks novelty due to the Scott prior art presented. Should further details be available to further illustrate the claimed invention's novelty, the examiner encourages the applicant and their representatives to amend the claims to reflect such features.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Boyer et al (US Pat No: US006268849B1).
- Rangan et al (US Pat No: US006154771A).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azizul Choudhury whose telephone number is (571) 272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AC



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